

In the parent case, the issue in the last Official Action (Final Rejection of March 21, 1995) was whether such amendment constituted an improper "recapture" of material deliberately cancelled in the parent application to obtain a patent. As will now be explained, such amendment is not an improper "recapture".

Firstly, as can be seen from the following table, in the definition of R¹ after the amendment of October 18, 1990 in application Serial No. 07/447,512, which became the patent in issue, acylamino, among other groups, were deleted.

<u>SN 07/447,512 as filed</u>	<u>SN 07/447,512 amended 10/18/90</u>	<u>This reissue application</u>
R ¹ amino hydroxy silylamine silyloxy acylamino acyloxy	R ¹ amino hydroxy	R ¹ amino hydroxy C ₂₋₃₀ acylamino

However, in this reissue application, these other groups are not again being claimed, and even acylamino has been limited to C₂ to C₃₀ groups.

The amendment of October 18, 1990 overcame the rejection of claims 1 to 3 as being anticipated by Takenuki, J. Med. Chem., 31(6), 1063-1064 (1988). It was pointed out in such amendment that:

The claims of the present application, as above amended, are directed to those compounds where R³ and R⁴ are selected from hydrogen, stearoyl and aminoacyl, with the exception of both being hydrogen, i.e., at least one of R³ and R⁴ are stearoyl or aminoacyl. On the other hand, R³ and R⁴ of the compounds of the cited reference are acyl or silyl.

The compounds of the present invention where R³ and/or R⁴ is (are) aminoacyl not disclosed or suggested by this reference. Moreover, there is no indication in this reference that such compounds exhibit antitumor and antiviral activity.

With regard to the case where R³ and/or R⁴ are stearoyl, there is submitted herewith the Rule 132 Declaration of N. Ashida which clearly demonstrates that such compounds exhibit excellent antitumor effects, which

effects are unpredictable from the cited reference.

In other words, the definition of R¹ was erroneously deleted, but such deletion was unnecessary since it was not needed to overcome the rejection on the Takenuki reference.

Further in this regard, attention is directed to MPEP § 1412.02, copy enclosed, which clearly indicates that a patentee is free to obtain claims of narrower scope than that surrendered during prosecution, without qualification.

Since it is clear that applicants are obtaining claims of narrower scope than that surrendered during prosecution, and since the surrendered material was not needed to distinguish over the prior art, there can be no doubt that applicants are not attempting an improper recapture of "claimed subject matter deliberately cancelled in an application to obtain a patent".


A Supplemental Reissue Declaration in support of the foregoing amendment will be forthcoming in the near future.

Lastly, enclosed is a photocopy of the Letters Patent, and the original Letters Patent will be surrendered upon an indication of allowance.

Favorable action is now requested.

Respectfully submitted,

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